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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,698	01/15/2004	Richard R. Rabbat	073338.0150 (03-52019 PLA)	8438
5073	7590	01/21/2009	EXAMINER	
BAKER BOTTS LLP, 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			CHRISS, ANDREW W	
ART UNIT	PAPER NUMBER			
	2419			
NOTIFICATION DATE	DELIVERY MODE			
01/21/2009	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/759,698	Applicant(s) RABBAT ET AL.
	Examiner Andrew Chriss	Art Unit 2419

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 October 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1.3-12,14-23 and 25-33 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 12 and 14-22 is/are allowed.

6) Claim(s) 1.3-11,23 and 25-33 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 15 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment, filed October 23, 2008, has been entered and carefully considered. Claims 1, 3, 5, 6, 12, 14, 16, 17, 23, 25, 27, and 28 are amended, Claims 2, 13, and 24 are canceled, and Claims 1, 3-12, 14-23, and 25-33 are currently pending.
2. In light of Applicant's amendment to Claims 1, 12, and 23, rejection of Claims 1, 5, 6, 8, and 11 under 102(b) and Claims 7, 9, 10, 12, 16-23, and 27-33 under 35 U.S.C. 103(a) is withdrawn.
3. In light of Applicant's amendment to Claims 5, 6, 16, 17, 27, and 28, objection to said claims is withdrawn.
4. In light of Applicant's amendment 6, 17, and 28, rejection of said Claims under 35 U.S.C. 112, second paragraph, is withdrawn.

Claim Rejections - 35 USC § 101

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. **Claims 1 and 3-11** rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method for provisioning protection paths is neither tied to a particular machine or apparatus nor transforming a particular article to a different state or thing (*In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). There is no method step in the claim language that is necessarily tied to a particular machine, such as identifying a machine that performs the claimed method. Therefore, the claimed method is not

ties to a particular machine. Further, the claimed method provides steps for provisioning/setting a protection path, but there is no transformation of a particular article to a different state or thing.

Claim Rejections - 35 USC § 112

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **Claims 23 and 25-33** rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between the claimed network interface, memory, and controller in independent Claim 23. Further, it is unclear how the claimed network interface interacts with the claimed network configuration information. Claims 25-33 depend on Claim 23, and fail to resolve the deficiencies therein.

9. **Claims 23 and 25-33** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is a lack of antecedent basis for claim language “the network configuration information” in Claim 23, line 3. Claims 25-33 depend on Claim 23, and fail to resolve the deficiencies therein.

Response to Arguments

10. Applicant's arguments filed October 23, 2008 regarding rejection of Claims 1 and 3-11 under 35 U.S.C. 101 have been fully considered but they are not persuasive. Applicant cites a

Board of Patent Appeals and Interferences ruling which states "[A]ll that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts."'" Examiner assumes that Applicant regards the invention as producing a useful, concrete, and tangible result. Examiner notes that in light of the Court of Appeals for the Federal Circuit opinion issued in *In Re Bilski*, the requirements for patentability under 35 U.S.C. 101 are twofold: the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. As described in the Office Action dated July 23, 2008 and further clarified above, the method claims in the instant application fail to satisfy either of the criteria delineated above. Therefore, rejection of Claims 1 and 3-11 under 35 U.S.C. 101 is maintained.

11. Applicant's arguments filed October 23, 2008 regarding rejection of Claims 23 and 25-33 under 35 U.S.C. 112, second paragraph, have been fully considered but they are not persuasive. Applicant concedes that a rejection under 35 U.S.C. 112, second paragraph, is proper if the claim "fails to interrelate essential elements of the invention as defined by applicant(s) in the specification." The claimed network node comprises a network interface, memory, and controller. But the claim language and Applicant's specification fail to provide any structural or cooperative relation between all three claimed elements. Examiner notes that the functionality of the claimed network node (i.e., provisioning a protection path) requires essential elements and relationships between the claimed components in order to achieve its intended goal. Absent claimed or disclosed interrelationships among these components, it is unclear how the protection

path would be set up, as per Applicant's claim language. Rejection of Claims 23 and 25-33 under 35 U.S.C. 112, second paragraph, is therefore maintained.

Allowable Subject Matter

12. **Claims 12 and 14-22 allowed.** Examiner's reasons for allowance are described in the Office Action mailed July 23, 2008.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Shinomiya et al (United States Patent Application Publication US 2002/0138645) discloses route protection design in a communication network.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Chriss whose telephone number is (571)272-1774. The examiner can normally be reached on Monday - Friday, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Chriss
Examiner
Art Unit 2419
1/8/2009

/Hassan Kizou/
Supervisory Patent Examiner, Art Unit 2419